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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,650	07/02/2003	Sreenivasulu Megati	WYTH-0015-100/AM100961	5472
35139	7590	11/18/2004	EXAMINER	
COZEN O' CONNOR, P. C.			DAVIS, ZINNA NORTHINGTON	
1900 MARKET STREET			ART UNIT	
PHILADELPHIA, PA 19103-3508			PAPER NUMBER	
			1625	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/612,650

Applicant(s)

MEGATI ET AL.

Examiner

Zinna Northington Davis

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12/16/2003
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-18 are pending.
2. This action is in response to the Remarks filed August 16, 2004. In the response, Group I, claims 1-11 is elected with traverse.

#### Response to the Restriction Requirement

Applicants have elected Group I, claims 1-11. Applicants traverse the restriction requirement. The traversal is based upon two criteria for a proper restriction which include: a) independent or distinct as claimed and 2) serious burden on the Office. Applicants state there will not be a serious burden on the Office to examine the entirety of the application. Applicants state a search of the invention of Group I will inevitably require searching the same art as the invention of claim 12 (Group II).

It is the Examiner's position:

- Based upon Applicant's remarks, the inventions of Group II and I will be examined together.
- Claims 1-12 will be examined as Group I.

Applicants state the examination of Group I will therefore inevitably require search the subject matter of Groups I-III. It is believe that examining the subject matter of Groups I-III would not pose a serious burden. In addition, examining Groups I-III together will result in the economies of the Patent Office as well as the Applicant.

It is the Examiner's position:

- The compounds of claims 13-18 are chemical intermediates. The prior art search for the process claims (claims 1) is different from the search of the intermediate compounds.
- The final compounds and intermediate compounds are patentably distinct.
- The serious burden to the Office would be searching more than a single inventive concept in a single patent application.
- As such, the restriction is deemed proper.
- Accordingly, applicants and the Examiner affirm the election of Group I wherein the claims 1-12 is the elected inventions.
- Claims 13-18 are withdrawn from consideration.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being clearly by anticipated by Harris et al (Reference A).


The instantly claimed invention is disclosed. At pages 2-4, see scheme I.

5. The Information Disclosure Statement filed December 16, 2003 has been considered.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

7. The fax phone number for the organization where this application is assigned is 703-872-9306 for regular communications.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number 571-272-1600.

  
**Zinna Northington Davis**  
**Primary Examiner**  
**Art Unit 1625**